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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,528	08/20/2001	Christophe Person	LXGN-00104	8324

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EXAMINER

ZEMAN, MARY K

ART UNIT PAPER NUMBER

1631

DATE MAILED: 09/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/933,528	<b>Applicant(s)</b> PERSON, CHRISTOPHE	
	<b>Examiner</b> Mary K Zeman	<b>Art Unit</b> 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 in total and claims 5-16 and 22-33 in part, drawn to a method of identifying a repeat sequence, classified in class 702, subclass 20.
- II. Claims 2, 3, 17-21 in total and claims 5-16 and 22-33 in part, drawn to a method of creating a repeat database, classified in class 707, subclass 6.
- III. Claims 4 and 36-38, drawn to a database product, classified in class 707, subclass 103R.
- IV. Claim 34, drawn to the process of Figure 2, classified in class 702, subclass 20.
- V. Claim 35, drawn to data resulting from a method, non-statutory and unclassifiable.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are independent and distinct, each from the other, as they are drawn to differing methods having differing goals, differing steps and achieving differing results. There are steps required for identifying a repeat that are not required for creating a database, and vice versa. As such, they would require search in differing areas that are not substantially overlapping. Search of such non-overlapping areas would pose a burden upon the examiner if not restricted.

Inventions I and III are independent and distinct, each from the other, as they are drawn to differing categories of invention. Invention I is drawn to a method of identifying a repeat sequence, while Invention III is drawn to a database of information. Invention III is not required

for the practice of Invention I, nor is Invention I required for Invention III. As such, the search of two independent inventions would pose an undue burden upon the examiner if not restricted.

Inventions I and IV are independent and distinct, each from the other, as they are drawn to differing methods having differing goals, differing steps and achieving differing results. As such, they would require search in differing areas that are not substantially overlapping. Search of such non-overlapping areas would pose a burden upon the examiner if not restricted.

Inventions I and V are independent and distinct, each from the other, as they are drawn to differing categories of invention. Invention I is a process of identifying a repeat sequence, while Invention V is drawn to data. While the data may result from the process of claim 1, the data itself is non-statutory and unclassifiable. The data can also be obtained by other methods. As such, they would require search in differing areas that are not substantially overlapping. Search of such non-overlapping areas would pose a burden upon the examiner if not restricted.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the database can be generated by other methods, and the database can be used in other methods. The process can be used to identify unique sequences, rather than repeat sequences.

Inventions II and IV are independent and distinct, each from the other, as they are drawn to differing methods having differing goals, differing steps and achieving differing results. As such, they would require search in differing areas that are not substantially overlapping. Search of such non-overlapping areas would pose a burden upon the examiner if not restricted.

Inventions II and V are independent and distinct, each from the other, as the data of Invention V does not result from the method of Invention II. As such, they would require search in differing areas that are not substantially overlapping. Search of such non-overlapping areas would pose a burden upon the examiner if not restricted.

Inventions III and IV are independent and distinct, each from the other, as the database is not made by the process of invention IV. As such, they would require search in differing areas that are not substantially overlapping. Search of such non-overlapping areas would pose a burden upon the examiner if not restricted.

Inventions III and V are independent and distinct, each from the other, as the data of invention V is not related to the database of invention III. As such, they would require search in differing areas that are not substantially overlapping. Search of such non-overlapping areas would pose a burden upon the examiner if not restricted.

Inventions IV and V are independent and distinct, each from the other, as the method of Invention IV does not produce the data of invention V. As such, they would require search in differing areas that are not substantially overlapping. Search of such non-overlapping areas would pose a burden upon the examiner if not restricted.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (703) 305-7133.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028.

The Official fax number for this Art Unit is: (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC1600 Receptionist whose telephone number is (703) 308-0196.

mkz  
9/17/03

  
MARY K. ZEMAN  
PRIMARY EXAMINER  
9/16/03